

Notice of Allowability

Application No.

09/396,701

Examiner

Prieto Beatriz

Applicant(s)

GUPTA ET AL.

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 05/27/04 (RCE).
2. ☒ The allowed claim(s) is/are 1-5, 13-25, 27-33 and 35-42.
3. ☒ The drawings filed on 09/15/99 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 5/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material

5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

Beatriz Prieto
Primary Examiner

Supplemental Notice of Allowance

1. This communication is in response to Request for continued examination filed under C.F.R. 1.114 filed 05/27/04, including the submission of and IDS for examiner's consideration.
2. Applicant's IDS filed in compliance with 37 CFR 1.97 requirements has been considered and initialed accordingly.
3. Claims as filed have been examined, further considered and/or search. Allowance is sustained.
4. The following is the Examiner's statement of Reason for Allowance. The prior art of record teaches the claimed invention substantially as claimed, however fails to teach or suggest individually or in combination the following limitations of the claimed invention; Regarding claims 1, and 3-5, prior art does not teach generating new annotation that include display located content data in an e-mail message, because the claimed term "new annotation" means that it is not based on existing annotation data, as in taught in the Hou reference. Thereby, generating a new annotation, which is not based on existing annotation data, is not taught by the prior art of record (as argued on pages 9-10 of brief). Prior art fails to teach analyzing an e-mail messages that are received not in reply to a previous mail message that included annotation data, because the Hou reference's annotation handler allows a new annotation to be made that is a reply to a selected segment from an e-mail message opened and retrieved from an mailbox database ("report") and then it generates the email message, however fails to teach where the e-mail is not in reply to a previous e-mail message. Thereby, analyzing an e-mail messages that are received not in reply to a previous mail message, is not taught by the prior art, hence claims 1, 3-5 are distinguishable over the prior art (as argued on pages 9-10 of brief). Regarding claim 17-25 and 27-30, prior art fails to teach wherein media content is being access for rendering to a user, beginning with the one of a plurality of temporal segments of the media content that corresponds to a new annotation, because the claimed clause "media content being accessed for rendering to a user", means rendering at a particular location of a media content, that is, the Birrell reference does not teach rendering media content (not bit) at a particular location, as recited in claim 17. Thereby claims 17-25 and 27-30 are distinguishable over the prior art (as argued on page 16 of brief). Regarding claims 31 and 32, prior art fails to teach displaying a default recipient corresponding to the identified one or more annotation sets, that is to receive an e-mail notification. Hou's markers that that used to specify annotations segments for playing back or for reply

segments, represented by voice-silence markers, are not analogous to claimed annotation sets, nor those the Hou reference teach a "default recipient to receive an e-mail", because the mail report handles including the searched and displayed mailing list in the reference used to deliver created e-mail does not correspond to an identified one or more of annotation sets, as claimed. Thereby, prior art fails to teach displaying a default recipient, corresponding to identify one or more annotations sets, as recited on claim 31. Regarding claims 33 and 35-36, prior art does not teach claim limitation as recited, creating after the plurality of electronic mail messages have been included in the e-mail thread, a plurality of annotations from the plurality of e-mail messages in the e-mail thread, as recited in claim 3, wherein the claimed limitation "creating plurality of annotations from the plurality of e-mail" is not analogous to prior arts adding and removing of labels (e.g. annotations) a plurality of e-mail messages, because the Birrell does not teach creating labels from a plurality of e-mail messages in an electronic mail thread. Thereby, prior art fails to teach the features of claims 33, and 35-36 (as argued on pages 19-20). Regarding claims 13-16 and 40, prior art does not teach an installation option in an e-mail that identifies an installation program for installing modules allowing content of new annotation included in the e-mail as well as the corresponding media content to be rendered. Prior art (Russell) teaches installation modules for allowing content to be displayed or rendered, Birrell teach email messages having annotations including media content, installation options in the form of files or programs such as applets or plug-ins or Java applets files downloadable over the network, these programs for rendering multimedia content, where the media content is included in e-mail messages to be rendered by the applet or installation option, however prior art does not teach where the installation option is included in an e-mail message, thereby the limitation of claim 13 are distinguishable over the prior art of record (as argued on pages 24-25). The limitations above discussed are those set forth on independent claim 1, 13, 17, 23, 25, 31, 33, 37 and 41. Claims are allowed because of the combination of other limitations and the limitation listed above.

5. Claims 1-5, 13-25, 27-33, and 35-42 are allowed because of the combinations of other limitations and the limitation listed above.

6. Any comments Applicants considers necessary must be submitted no later than the payment of the Issue Fee and to avoid processing delays, should preferable accompany the Issue Fees. Such submission should be clearly labeled "Comments on Statement of Reasons for Allowance". In event of any post-allowance papers (e.g. IDS, 312 amendment, petition, etc.), Applicant is exhorted to mail papers to the Production Control branch in Publications or faxed to post-allowance papers correspondence

branch at (703) 308-5864 to expedite issuing process or call PUB's Customer Service if any questions at (703) 305-8497.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. Prieto whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:30 to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

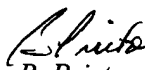
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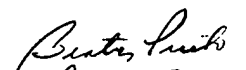
or faxed to:

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B. Prieto
Primary Examiner
March 5, 2005


Primary Examiner